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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,813	08/04/2004	Grover Mundell	43576.830009.US1	4812
26582	7590	08/07/2008		
HOLLAND & HART, LLP P.O BOX 8749 DENVER, CO 80201			EXAMINER LY, CHEYNE D	
			ART UNIT 2168	PAPER NUMBER
			MAIL DATE 08/07/2008	DELIVERY MODE PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/710,813  
Filing Date: August 04, 2004  
Appellant(s): MUNDELL ET AL.

\_\_\_\_\_  
Shane M. Niebergall (Reg. No. 44,974)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 15, 2008 appealing from the Office action mailed November 27, 2007.

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**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

2003/0078973	Przekop et al.	04-2003
6,462,754	Chakraborty et al.	10-2002

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 3-11, and 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Przekop et al. (US 2003/007,8973 A1 Przekop hereafter) taken with Chakraborty et al. (6,462,754 B1 Chakraborty hereafter).
2. In regard to claim 1, Przekop describes a method for managing electronic transcripts and electronic exhibits performed on at least one processor, the method comprising the steps of:  
selecting an electronic transcript file to have establish an electronic link with at least one electronic exhibit (page 2, [0012], e.g. each line of the transcript contains a selectable link to the video/audio record so that a permitted viewer, by simply selecting a link, is securely navigated to the corresponding portion of the video/audio record over a public network such as the Internet);
3. synchronizing a media file with the electronic transcript (page 3, [0033], e.g. .PDF files synchronization);
4. identifying at least one electronic exhibit to be electronically linked with the electronic transcript by electronic link association (page 2, [0012], e.g. each line of the transcript contains a selectable link to the video/audio record so that a permitted viewer, by simply selecting a link, is securely navigated to the corresponding portion of the video/audio record over a public network such as the Internet);
5. choosing a type of electronic link between the electronic transcript and the at least one electronic exhibit (page 2, [0012], e.g. each line of the transcript contains a selectable link to

the video/audio record so that a permitted viewer, by simply selecting a link, is securely navigated to the corresponding portion of the video/audio record over a public network such as the Internet);

6. applying the electronic link to the electronic transcript such that the electronic transcript and the at least one electronic exhibit are linked to cause the at least one electronic exhibit to automatically displayed as the electronic transcript and the synchronized media file are advanced passed the electronic link (page 3, [0035], e.g. automated system, and page 4, [0036], member reviews 203 desired portions of the video/audio record by selecting the corresponding link in the transcript, as shown in FIG. 3. Thus, when the member clicks on the line number, the software opens the browser window and launches the streaming-video-on-demand services, presenting the desired portion of the video/audio record in its own frame).

7. However, Przekop does not explicitly describe the limitation of a user defined electronic link.

8. Chakraborty describes the limitation of inputting the user defined electronic link (column 15, lines 34-39). While, Przekop describes it would be desirable to embed selectable links in the transcript so that group members could access a desired portion of the video record by selecting the link embedded in the corresponding line of the transcript (page 1, [0011]).

9. Chakraborty describes a need exist to automatic hyperlinking video clips to different parts of a document system (page 3, lines 3-6). While, Przekop describes an improvement in a system using open standards as much as possible, thus enabling reduced cost to users, ease of implementation, ease of use, and maximum compatibility and portability by embedding

selectable links in the transcript so that group members could access a desired portion of the video record by selecting the link embedded in the corresponding line of the transcript (page 1, [0011]).

10. Therefore, one of ordinary skill in the art at the time of the invention would have been motivated by improve the system of Chakraborty to reduce cost to users, ease of implementation, ease of use, and maximum compatibility and portability. Therefore, it would have been obvious to one of ordinary skill in the art to make and use the system of Przekop with the user defined line as described by Chakraborty.

11. In regard to claim 3, Przekop in view of Chakraborty describes activating the applied electronic link; and displaying the at least one electronic exhibit (page 2, [0012], e.g. each line of the transcript contains a selectable link to the video/audio record so that a permitted viewer, by simply selecting a link, is securely navigated to the corresponding portion of the video/audio record over a public network such as the Internet).

12. In regard to claim 4, Przekop in view of Chakraborty describes displaying the electronic transcript in a first window; and displaying the at least one electronic exhibit in at least a second window (Figures 3 and 4, e.g. windows).

5. In regard to claim 5, Przekop in view of Chakraborty describes the step of displaying the at least one electronic exhibit comprises the step of displaying an image (page 4, [0036]).

6. In regard to claim 6, Przekop in view of Chakraborty describes the step of displaying the at least one electronic exhibit comprises playing an audio file (page 2, [0012]).

7. In regard to claim 7, Przekop in view of Chakraborty describes the step of displaying the at least one electronic exhibit comprises playing a video file (page 2, [0012]).

8. In regard to claim 8, Przekop in view of Chakraborty describes the step of displaying the at least one electronic exhibit comprises playing an audio/video file (page 2, [0012]).

13. In regard to claim 9, Przekop in view of Chakraborty describes appending the media file to the electronic transcript (page 4, [0037], e.g. appending).

14. In regard to claim 10, Przekop in view of Chakraborty describes the step of launching the media file in a media window (Figures 3 and 4, e.g. windows).

15. In regard to claim 11, Przekop in view of Chakraborty describes the step of advancing the electronic transcript along with the media file (page 2, [0012], e.g. each line of the transcript contains a selectable link to the video/audio record so that a permitted viewer, by simply selecting a link, is securely navigated to the corresponding portion of the video/audio record over a public network such as the Internet).

16. In regard to claim 13, Przekop in view of Chakraborty describes the step of recognizing the characters of the at least one electronic exhibit to provide character searching of the at least one electronic exhibit (page 4, [0042], e.g. searched for occurrences of the particular term).

17. In regard to claim 14, Przekop in view of Chakraborty describes the step of importing a file to a project, the file selected from a group of files consisting of electronic transcript files and electronic exhibit files (page 5, [0050] to [0055]).

18. In regard to claims 15, 16, 21, 22, and 24, Przekop in view of Chakraborty describes, in addition to the disclosures cited above, the transcript manager, an organization and control module (Figures 1 and 2 in their entirety), memory (Figure 1), and display (Figures 3 and 4).

19. In regard to claims 17 and 18, Przekop in view of Chakraborty describes a network via broadband connection or wireless connection (page 3, column 2, [0032]).

20. In regard to claims 19 and 20, Przekop in view of Chakraborty describes "floppy disk of the transcript" (page 4, [0044], e.g. CD-ROM).

#### **(10) Response to Argument**

21. On pages 4-5, Appellant argues Przekop et al. and Chakraborty are silent regarding automatically displaying the exhibit. Appellant argument is not persuasive because Przekop has been cited to describe the argued limitation. For example, Przekop describes an automated system (page 3, [0035]). Members review desired portions of the video/audio record by selecting the corresponding link in the transcript, as shown in FIG. 3. Thus, when the member clicks on the line number, the software opens the browser window and launches the streaming-video-on-demand services, presenting the desired portion of the video/audio record in its own frame (page 4, [0036]). The above reasonably describe the argued limitation of automatically displaying the exhibit.

22. The instant specification does not define the automatically displaying to be distinct from the automated system of Przekop. Therefore, the disclosure of Przekop has been interpreted as accomplishing the same expected result as the claimed method. Further, the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

23. On page 5, Appellant argues the electronic transcripts of Przekop are the same information as the video/audio records, but in different file formats while the claimed

invention is directed to electronic transcripts and electronic exhibit files, which are specifically different terms relating to files containing different information. Appellant's argument is not persuasive because the cited disclosure is consistent with the exemplary disclosure of electronic transcripts and electronic exhibit files by the instant specification (paragraph [0003]). Further, Przekop describes the technologies for making video/audio recordings of depositions and associating said depositions with the textual transcripts wherein the video portion is distinct from the textual transcript (page 1, [0005], e.g. deponents visual appearance, and voice timbre and tone, and [0011]).

24. On pages 5-7, Appellant argues the combination of elements are not disclosed in the cited prior art...Nor has the Examiner identified the reason why a person of ordinary skill in the art would have combine the prior art. Appellant's arguments are not persuasive as discussed below. For example, Chakraborty describes a need exist to automatic hyperlinking video clips to different parts of a document system (page 3, lines 3-6). While, Przekop describes an improvement in a system using open standards as much as possible, thus enabling reduced cost to users, ease of implementation, ease of use, and maximum compatibility and portability by embedding selectable links in the transcript so that group members could access a desired portion of the video record by selecting the link embedded in the corresponding line of the transcript (page 1, [0011]). Therefore, one of ordinary skill in the art at the time of the invention would have been motivated by improve the system of Chakraborty to reduce cost to users, ease of implementation, ease of use, and maximum compatibility and portability. Therefore, it would have been obvious to one of ordinary skill

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in the art to make and use the system of Przekop with the user defined line as described by Chakraborty.

25. As for the argued limitation of “automatically displaying exhibits”, the argued limitation has been addressed as discussed above.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Cheyne D Ly/ CDY  
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